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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,301	09/02/2003	Randall Jay Briggs	100205079-1	2760

22879 7590 07/28/2005

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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/653,301

Applicant(s)

BRIGGS ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
 4a) Of the above claim(s) 5-12, 17-21, 24, 25, 30, 31, 34 and 35 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-4, 13-16, 22, 23, 26-29, 32 and 33 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 9/24/03.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____

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1. Applicant's election of Group I, claims 1-4, 13-16, 22, 23, 26-29, 32 and 33 in the reply filed on 6/20/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 14, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al. (5,265,083; hereinafter Ishii'083). Ishii'083 discloses a portable disc player/electronic device (1) comprising a compact disc holder (10) integrated with the portable electronic device. The compact disc holder comprises a central opening retainer and the central opening retainer is unitarily formed with a mounting surface (9) of the portable electronic device. As to claim 4, an edge around the mounting surface (9, Figure 3) is considered equivalent to at least one ridge as claimed. Claims 32 and 33 are anticipated by the method of using the device of Ishii'083.

4. Claims 1-3, 14, 22, 23, 26, 28, 32 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Howell (6,621,691). Howell discloses a portable computer/electronic device (10)

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comprising a compact disc holder (60) integrated with the portable electronic device. The compact disc holder comprises a central opening retainer and the central opening retainer is unitarily formed with a mounting surface of the portable electronic device. As to claim 22, when a door (48) is in an opened position, the means for securing the compact disc on an exterior of the portable electronic device. Claims 32 and 33 are anticipated by the method of using the device of Howell.

5. Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Cloran et al. (5,950,822; hereinafter Cloran'822). Cloran'822 discloses a mountable device/compact disc holder (10) for the display and storage of a compact disc comprising a central opening retainer (20) having a plurality of resilient tabs (21) for securing the compact disc. Cloran'822 states "the device 10 can be attached to a multitude of surfaces, either indoors or outdoors, such as computer hardware, stereos, televisions, monitors, posters, walls car dashboards, entertainment centers, printers, furniture, etc." (column 4, lines 58-62). When the holder (10) attached to the surfaces as indicated above is considered equivalent to a compact disc holder integrated with a portable electronic device as claimed. Claims 32 and 33 are anticipated by the method of using the device of Cloran'822.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3, 13-15, 22, 23, 26-29, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloran et al. (5,950,822; hereinafter Cloran'822) in view of Wolff (5,933,772). Cloran'822 discloses the mountable device/compact disc holder (10) for the display and storage of a compact disc as above having all the limitations of the claims. To the extent that Cloran'822 fails to show a portable electronic device, Wolff teaches a portable electronic device (P) such as pager or other portable item (column 1, lines 45-46) integrated with a coin holder (10) to provide more convenience for a user. The coin holder may be formed integrally with the housing of the pager or other portable item. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Wolff to modify the holder of Cloran'822 so the holder is used for attaching to a portable electronic device to provide more convenience for the user. Claims 32 and 33 are drawn to the obvious method of using the holder of Cloran'822 as modified.

9. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 2 and 15 above, and further in view of Cerda-Vilaplana et al. (5,933,772; hereinafter Cerda-Vilaplana'186) or Sommi (5,570,791). The holder of Cloran'822

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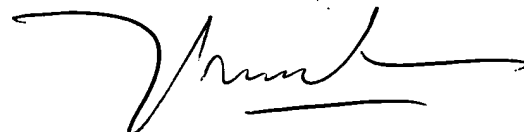
further fails to show at least one ridge. Cerda-Vilaplana'186 shows a disc holder comprising a central opening retainer (2, 4, 5, 8) for retaining a central opening of a compact disc and at least one ridge (9) for protecting an edge of the compact disc. Sommi suggests a disc holder (10, 12) comprising a central opening retainer (22) for retaining a central opening of a compact disc and at least one ridge (30) for protecting an edge of the compact disc. It would have been obvious to one having ordinary skill in the art in view of Cerda-Vilaplana'186 or Sommi to modify the holder of Cloran'822 as modified so the holder includes at least one ridge for protecting the edge of the compact disc to prevent the edge from being damaged.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Errica Miller at (571) 272-4370.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (571) 273-8300 for Formal papers and After Final communications.

lkb
July 25, 2005



Luan K. Bui
Primary Examiner